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10/561,010	04/18/2007	Myriam Bouet-Griffon	2901683-000026	6015

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Baker Donelson Bearman Caldwell & Berkowitz PC  
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EXAMINER
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LEE, REBECCA Y

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1734

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/561,010  
Filing Date: April 18, 2007  
Appellant(s): BOUET-GRIFFON ET AL.

\_\_\_\_\_  
Susan E. Shaw Mcbee  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 17<sup>th</sup> December 2010 appealing from the  
Office action mailed 5<sup>th</sup> August 2010.

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

Claims 2 and 6 are cancelled. Claims 1, 3-5 and 7-20 are finally rejected and under appeal.

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

**(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

**(8) Evidence Relied Upon**

JP 2002371333	Sato et al.	12-2002
US 6678936	Izumi et al.	01-2004

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 11 and 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al. (JP 2002-371333).

Sato et al. teach an aluminum alloy sheet with a thickness of 1 mm, having a composition relative to that of the instant invention, in weight percent, as shown in the table below (abstract and section 0034).

Element	Instant claims	Sato et al.	overlap
Si	0.7-1	0.4-1.8	0.7-1
Fe	0-0.5	0.02-0.5	0.02-0.5
Cu	0.8-1.1	0.1-1.5	0.8-1.1
Mn	0.45-0.6	0.03-1.5	0.45-0.6
Mg	0.6-0.9	0.2-1.6	0.6-0.9
Zn	0.15-0.3	0.05-6	0.15-0.3
Cr	0-0.25	0.02-0.5	0.02-0.25
Zr+Ti	0-0.20	Zr: 0.02-0.5 Ti: 0.003-0.2 Zr+Ti: 0.023-0.7	0.023-0.20
Other elements	<0.05 each <0.15 total	0+	<0.05 each <0.15 total
Al	balance	balance	balance

The amounts of Si, Fe, Cu, Mn, Mg, Zn, Cr, Zr, Ti and Al disclosed by Sato et al. overlap the claimed amounts of Si, Fe, Cu, Mn, Mg, Zn, Cr, Zr, Ti and Al, which is prima facie evidence of obviousness MPEP 2144.05 I. It would have been obvious to one of ordinary skill in the art at the time of invention to have selected claimed amounts of Si, Fe, Cu, Mn, Mg, Zn, Cr, Zr, Ti and Al from the amounts disclosed by Sato et al. since Sato et al. discloses the same utility throughout the disclosed ranges.

Sato et al. further teach the aluminum alloy sheet would have a yield strength greater than 220 MPa before and after the paint baking (table 3), which overlaps the claimed ranges.

Even though Sato et al. do not expressly teach the yield strength after solution treatment, quenching and aging, such properties would have been expected since Sato et al. disclose a substantially identical alloy sheet as claimed MPEP 2112.01.

In addition, the claimed limitations of solution treatment, quenching and aging steps are considered as process limitations in product by process claims. It is well settled that a product-by-process claim defines a product, and that when the prior art discloses a product substantially the same as that being claimed, the burden falls upon the applicant to show that any process steps associated therewith results in a product materially different from that disclosed in the prior art. See *In re Thorpe*, (227 USPQ 964), *In re Brown*, (173 USPQ 685), *In re Fessman*, (180 USPQ 524) and MPEP 2113. In this case, Sato et al. teach an aluminum alloy that is substantially the same as claimed. Therefore, the burden falls upon the applicant to show that the process steps of Sato et al. result in a materially different Al alloy product.

Furthermore, Sato et al. teach the aluminum alloy sheet, which is subjected to paint baking as claimed, would be used as automobile material (section 0001), and attached to a steel component, such as a body skin part as claimed.

Claims 1, 3-5, 7-10, 12-13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al. (JP 2002-371333) in view of Izumi et al. (US 6678936).

Sato et al. teach an aluminum alloy sheet with a thickness of 1 mm, having a composition relative to that of the instant invention, in weight percent, as shown in the table below (abstract and section 0034).

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Element	Instant claims	Sato et al.	overlap
Si	0.7-1	0.4-1.8	0.7-1
Fe	0-0.5	0.02-0.5	0.02-0.5
Cu	0.8-1.1	0.1-1.5	0.8-1.1
Mn	0.45-0.6	0.03-1.5	0.45-0.6
Mg	0.6-0.9	0.2-1.6	0.6-0.9
Zn	0.15-0.3	0.05-6	0.15-0.3
Cr	0-0.25	0.02-0.5	0.02-0.25
Zr+Ti	0-0.20	Zr: 0.02-0.5 Ti: 0.003-0.2 Zr+Ti: 0.023-0.7	0.023-0.20
Other elements	<0.05 each <0.15 total	0+	<0.05 each <0.15 total
Al	balance	balance	balance

The amounts of Si, Fe, Cu, Mn, Mg, Zn, Cr, Zr, Ti and Al disclosed by Sato et al. overlap the claimed amounts of Si, Fe, Cu, Mn, Mg, Zn, Cr, Zr, Ti and Al, which is prima facie evidence of obviousness MPEP 2144.05 I. It would have been obvious to one of ordinary skill in the art at the time of invention to have selected claimed amounts of Si, Fe, Cu, Mn, Mg, Zn, Cr, Zr, Ti and Al from the amounts disclosed by Sato et al. since Sato et al. discloses the same utility throughout the disclosed ranges.

Sato et al. further teach the aluminum alloy sheet would have a yield strength greater than 220 MPa before and after the paint baking (table 3), which overlaps the claimed ranges.

Even though Sato et al. do not expressly teach the yield strength after solution treatment, quenching and aging, such properties would have been expected since Sato et al. disclose a substantially identical alloy sheet as claimed MPEP 2112.01.

In addition, the claimed limitations of solution treatment, quenching and aging steps are considered as process limitations in product by process claims. it is well

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settled that a product-by-process claim defines a product, and that when the prior art discloses a product substantially the same as that being claimed, the burden falls upon the applicant to show that any process steps associated therewith results in a product materially different from that disclosed in the prior art. See *In re Thorpe*, (227 USPQ 964), *In re Brown*, (173 USPQ 685), *In re Fessman*, (180 USPQ 524) and MPEP 2113. In this case, Sato et al. teach an aluminum alloy that is substantially the same as claimed. Therefore, the burden falls upon the applicant to show that the process steps of Sato et al. result in a materially different Al alloy product.

Furthermore, Sato et al. teach the aluminum alloy sheet, which is subjected to paint baking as claimed, would be used as automobile material (section 0001), and attached to a steel component, such as a body skin part, but do not expressly teach that the aluminum alloy would be a body roof.

Izumi et al. teach aluminum alloys would be used as a body roof (Column 1, lines 13-23).

It would have been obvious to one of ordinary skill in the art to use the aluminum alloy of Sato et al. as a body roof, as claimed, with expected success.

#### **(10) Response to Argument**

Appellant argues that Sato does not teach the claimed process limitation of “treated by solutionizing, quenching and age hardening at room temperature”. However, as stated above, such limitations are considered as process limitations in product-by process claims. It is well settled that a product-by-process claim defines a product, and



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that when the prior art discloses a product substantially the same as that being claimed, the burden falls upon the applicant to show that any process steps associated therewith results in a product materially different from that disclosed in the prior art. See *In re Thorpe*, (227 USPQ 964), *In re Brown*, (173 USPQ 685), *In re Fessman*, (180 USPQ 524) and MPEP 2113. In this case, Sato et al. teach an aluminum alloy that is substantially the same as claimed. Therefore, the burden falls upon the appellant to show that the process steps of Sato et al. result in a materially different Al alloy product. Because appellant has not provided any factual evidence to show that the recited process would have resulted in a materially different Al alloy product, appellant's argument is not found convincing.

Appellant also argues that none of the exemplified alloys of Sato et al. has the claimed composition, and Sato et al. do not expressly teach the claimed properties. However, the teachings of Sato et al. do not limit to the exemplified alloys. Taking the Sato reference as a whole, Sato teaches an Al alloy product with overlapping composition as instantly claimed, which is prima facie evidence of obviousness MPEP 2144.05 I. In addition, Sato et al. further teach the aluminum alloy sheet would have a yield strength greater than 220 MPa before and after the paint baking (table 3), which overlaps the claimed ranges.

Appellant tries to establish unexpected results by referring to the declaration of Gilles Guiglionda (paragraphs 18-20). However, Paragraphs 18-20 of the declaration do not provide any factual data to support appellant's assertion of unexpected result. In addition, please be noted that such declaration has been considered and previous

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rejections based on Evancho et al. have already been withdrawn. No declaration in response to the rejections based on Sato et al. has been submitted.

Appellant again argues that the combined references do not teach the claimed yield strength. However, as stated above, Sato et al. teach the aluminum alloy sheet would have a yield strength greater than 220 MPa before and after the paint baking (table 3), which overlaps the claimed ranges. In addition, such property would be expected in Sato et al. since Sato et al. teach a substantially identical aluminum alloy product as instantly claimed MPEP 2112.01.

Appellant also argues that the combined references do not teach the claimed body roof. However, as stated above, Sato et al. teach the aluminum alloy sheet would be used as automobile material (section 0001), and attached to a steel component, such as a body skin part, and Izumi et al. teach such aluminum alloys would be used as a body roof (Column 1, lines 13-23), thus, it would have been obvious to one of ordinary skill in the art at the time of invention to use the aluminum alloy of Sato et al. as a body roof, as claimed, with expected success. Because appellant has not provided any factual evidence to show that the aluminum alloy of Sato et al. could not be used as a body roof, appellant's argument is not found convincing.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

/REBECCA LEE/

Examiner, Art Unit 1734

Conferees:

/Emily M Le/

Supervisory Patent Examiner, Art Unit 1734

/Gregory L Mills/

Supervisory Patent Examiner, Art Unit 1700